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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,463

04/21/2005

Atsushi Nakayama

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EXAMINER

NERANGIS, VICKY MARIE

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

04/08/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/516,463	<b>Applicant(s)</b> NAKAYAMA ET AL.	
	<b>Examiner</b> Vickey Nerangis	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
2. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl et al (US 5,663,226).

The rejection is adequately set forth in paragraph 4 of Office action mailed on 11/17/2008 and is incorporated here by reference.

### ***Response to Arguments***

4. Applicant's arguments filed 12/29/2009 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the declaration filed on 12/29/2009 establishes unexpected results for the instant invention and (B) that Scholl et al fails to disclose a decylene or phenylene groups.

With respect to argument (A), it is noted that the newly submitted examples are a proper side-by-side comparison because the relative amounts of silane compound are the same. This discussion will be separated out based on claim 1 (and claims dependent thereon) and claim 13 (and claims dependent thereon).

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Concerning claim 1, the data in Table B is insufficient to establish unexpected results because the data is not reasonably commensurate in scope with the scope of the claims for two reasons. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). First, the comparison is only for silane compounds including formula (III) and not formula (IV). Second, the data which discloses R<sup>6</sup> and R<sup>7</sup> that is hexylene or decylene is not reasonably commensurate in scope with the claimed R<sup>6</sup> to R<sup>10</sup> groups that can also be divalent aromatic groups or divalent hetero atom-containing groups. There is nothing on the record to show that hexylene or decylene is functionally equivalent to divalent aromatic groups or divalent hetero atom-containing groups.

Concerning claim 13, the data in Table A is insufficient to establish unexpected results because the data which discloses R<sup>5</sup> that is decylene is not reasonably commensurate in scope with the claimed R<sup>5</sup> that can also be phenylene. There is nothing on the record to show that decylene is functionally equivalent to phenylene.

With respect to argument (B), Scholl et al's formula (I) in col. 1, line 43 discloses that X<sup>1</sup> can be alkylene groups, X<sup>2</sup> group can be C<sub>1</sub>-C<sub>12</sub> alkyl (i.e., includes decylene), and that Y can be C<sub>1</sub>-C<sub>18</sub> alkyl (i.e., includes decylene) or aromatic C<sub>6</sub>-C<sub>12</sub> aryl groups. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize decylene or phenylene groups in the reinforcing additive formula given that Scholl et al teaches such.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

vn

/Vickey Nerangis/  
Primary Examiner, Art Unit 1796